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EXAMINER				
SINGH, DALZID E				
ART UNIT		PAPER NUMBER		
2613				
NOTIFICATION DATE		DELIVERY MODE		
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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# Office Action Summary

## Application No.

09/930,095

## Applicant(s)

MONGA, INDERMOHAN S.

## Examiner

Dalzd Singh

## Art Unit

2613

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 4/10/09.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- 7) ☐ Paper No(s)/Mail Date: \_\_\_\_\_

**DETAILED ACTION**

***Claim Rejections - 35 USC § 101***

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claim(s) 1-5 are rejected under 35 U.S.C. 101 as not falling within one of the four statutory categories of invention. While the claims recite a series of steps or acts to be performed, a statutory “process” under 35 U.S.C. 101 must (1) be tied to another statutory category (such as a particular apparatus), or (2) transform underlying subject matter (such as an article or material) to a different state or thing (see the May 15, 2008 memorandum issued by Deputy Commissioner for Patent Examining Policy, John J. Love, titled “Clarification of ‘Processes’ under 35 U.S.C. 101”). The instant claims neither transform underlying subject matter nor positively tie to another statutory category that accomplishes the claimed method steps, and therefore do not qualify as a statutory process.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-4, 6-10, 12-17 and 20-24 are rejected under 35 U.S.C. 102(e) as being anticipated by Bagga et al (US Patent No. 7,197,546).

Regarding claims 1, 6 and 12, Bagga et al discloses a method for provisioning network services for a user application in an optical communication system, as shown in Fig. 6, the method comprising:

ascertaining communication requirements of the user application (600);

determining a set of application-specific optical network communication services for the user application based at least in-part upon the ascertained communication requirements and non-requirements of the user application, the communications services including at least one of unshared lightpath, shared lightpath, routed path, latency, error rate, and protection mechanism (see col. 6 line 67 to col. 7, line 13; col. 7, lines 44-62 and col. 8, lines 11-33;602; for example, route requirement is the selected route path; the system is capable of providing various services therefore a selected service will be considered as required and the un-selected service is considered

as non-requirements; application-specific is considered as the selected service that is able to perform the required user application); and

obtaining, from the optical network, the ascertained communication services for the user application (604-608).

Regarding claims 2, 7, 14 and 23, wherein determining a set of communication services for the user application based at least in-part upon the ascertained communication requirements and non-requirements of the user application comprises mapping the user application communication requirements and non-requirements to the optical network communication services (see Fig. 6; the provision is completed, therefore the user application is mapped to desired result).

Regarding claims 3, 8, 15 and 24, wherein obtaining the communication services for the user application comprises interacting with a core optical communication network to obtain the communication services for the user application (see col. 3, lines 25-32).

Regarding claim 4, Bagga et al disclose the core optical communication network comprises an automatically switched optical network (ASON) (in col. 3, lines 25-32, Bagga et al teach the use of optical switch, therefore it is inherent that such switch in automatically controlled to direct connection between ports).

Regarding claims 9, 10, 16, 17 and 21, wherein the optical communication network comprises an automatically switched optical/transport network (ASON), and wherein the UNI comprises an ASON UNI (in col. 3, lines 25-32, Bagga et al teach the

use of optical switch, therefore it is inherent that such switch is automatically controlled to direct connection between ports; it is inherent that the system comprise of UNI or user-to-network interface).

Regarding claims 13 and 22, Bagga et al disclose logic for ascertaining communication requirements and non-requirements of the user application; for determining a set of communication services for the user based at least in-part upon the communication requirements and non-requirements of the user application; and for obtaining the communication services for the user application (see Fig. 6; in step 602, for example, route requirement is the selected route path; the system is capable of providing various services therefore a selected service will be considered as required and the un-selected service is considered as non-requirements; application-specific is considered as the selected service that is able to perform the required user application).

Regarding claim 20, Bagga et al disclose system, as shown in Fig. 1, comprising: an optical communication network (Fig. 1); and a network user application (210) coupled to the optical communication network, wherein the network user application comprises an optical service agent for obtaining application-specific optical communication services from the optical communication network via a user-to-network interface (UNI) sufficient to support operation of the network user application, the communications services including at least one of unshared lightpath, shared lightpath, routed path, latency, error rate, and protection

mechanism (see col. 6 line 67 to col. 7, line 13; col. 7, lines 44-62 and col. 8, lines 11-33; see Fig. 6; in step 602, for example, route requirement is the selected route path; the system is capable of providing various services therefore a selected service will be considered as required and the un-selected service is considered as non-requirements; application-specific is considered as the selected service that is able to perform the required user application; it is inherent that the system comprise of UNI or user-to-network interface).

### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 5, 11, 18, 19 and 25-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bagga et al (US Patent No. 7,197,546) in view of Ramaswami et al (US Patent No. 5,781,537).

Regarding claims 5, 11, 18, 19 and 25-27, Bagga et al discloses determining the communication services for the user application comprises interacting with network user application to determine the set of communication services for the user application (as shown in Fig. 5, Bagga et al show various connections which is capable of interacting

with various networks) and differ from the claimed invention in that Bagga et al does not specifically disclose interfacing with peer network. However, interfacing with a peer network is well known. Ramaswami et al teach communication network which interfaces with peer network (see col. 1, lines 57-64). Therefore, since Bagga et al discloses communication network capable of communicating with various networks, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to interface the communication network of Bagga et al to peer network in order to provide access to the conventional networks. Furthermore, it is inherent that peer network comprises the required interface in order to communicate with other networks.

### ***Response to Arguments***

7. Applicant's arguments filed 10 April 2009 have been fully considered but they are not persuasive.

On page 8, in response to the 35 U.S.C. 101 rejection, applicant argues that *"The optical network is a physical apparatus including physical machines interconnected by a physical communication medium, and those physical machines are necessarily altered when service is obtained from them as recited in the claims, e.g., by physically repositioning mirrors in the case of a MEMs switch. The utility of the recited invention is to cause that alteration of the optical communication network in order to obtain application-specific services. Withdrawal of the rejection is therefore requested."*



Claim 1 is a method claim which recites steps of "ascertaining .... determining ... obtaining, ..." It is unclear which apparatus is performing these steps. There is no known apparatus which inherently performs these steps. These steps could be interpreted as mental steps.

On page 9, applicant argues that "... *there is no suggestion in Bagga of consideration of application-specific requirements or services.*" Unless applicant has a specific definition of "*application –specific*", Bagga et al clearly teaches such limitation. In col. 7, lines 44-62, Bagga et al discloses "*customer **specifies the type of service that they would like***" This has been interpreted as "application-specific".

On page 10 of the remark, applicant argues that "*More particularly, an OSA application component is tightly coupled to the user application to enable the user application to obtain network services<sup>3</sup> without the human intervention described by Bagga.*" In col. 7, lines 55-58, Bagga et al disclose that the network services may be provided by user guided or automatic.

***Conclusion***

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dalzid Singh whose telephone number is (571) 272-3029. The examiner can normally be reached on Mon-Fri 9am - 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jason Chan can be reached on (571) 272-3022. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Dalzid Singh/  
Primary Examiner  
Art Unit 2613